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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,080	10/12/2001	Gerald R. Black	60,512-003	1167

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EXAMINER

DANG, DUY M

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,080

Applicant(s)

BLACK, GERALD R.

Examiner

Duy M. Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 0205 and 23 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment filed 3/2/05 and 3/23/05 have been entered and made of record.
2. Applicant's arguments filed 3/2/05 with respect to claims 20-51 have been fully considered and are persuasive.
3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 20-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-23 of U.S. Application No. 09/865,756 (referred as the copending invention '756 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as follows:

It is noted that claims 20-51 of the instant application is a broader recitation of the invention and the claim 20-23 of the copending invention '756 covers the equivalent subject matter as that of claims 20-51 of the instant application. Specifically, each of the limitations of

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claims 20-51 of the instant application is set forth in claims 20-23 of the copending invention '756. While the copending claims 20-23 include additional limitations not set forth in claim 20-51 of the instant application, the use of transitional term "comprising" in the instant claims 20-51 fails to preclude the possibility of additional elements. Therefore, claim 20-51 of the instant application fails to define an invention that is patentably distinct from claim 20-23 of the copending invention '756.

5. Claims 20-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Application No. 09/865,638 (referred as the copending invention '638 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as follows:

It is noted that claims 20-51 of the instant application is a broader recitation of the invention and the claim 1-33 of the copending invention '636 covers the equivalent subject matter as that of claims 20-51 of the instant application. Specifically, each of the limitations of claims 20-51 of the instant application is set forth in claims 1-33 of the copending invention '638. While the copending claims 1-33 include additional limitations not set forth in claim 20-51 of the instant application, the use of transitional term "comprising" in the instant claims 20-51 fails to preclude the possibility of additional elements. Therefore, claim 20-51 of the instant application fails to define an invention that is patentably distinct from claim 1-33 of the copending invention '638.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 20-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over [US Pat. No. 5,103,486. Art of record, IDS filed 12/20/01] in view of Yong [US Patent No. 5,869,791] and Borza [US Patent No. 6,076,167].

The advanced statement with regard to Grippi in the previous Office action is incorporated herein after. Regarding a representative claim 20, Grippi teaches a stylus for use as an identity verification device [see hand held writing device 10 of figures 1-3 and 5], the stylus being coupled to a processor [see verification system 66 of figure 5 comprises a microprocessor according to col. 6 lines 36-41] comprising: a stylus body [see shell 12 of figures 1-3].

Yong teaches a sensor coupled to the stylus body, the sensor being adapted to capture a thumbprint of a user finger touches the sensor coupled to the stylus body [see col. 11 lines 12-19].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Grippe's stylus by incorporate the sensor for capturing fingerprint as taught by Young as suggested by Yong in col. 11 lines 12-19. By including sensor for capturing fingerprint in a stylus would greatly allow broader application, and more compact for fingerprint input device.

The combination of Grippi and Yong fails to teach the use of thumbprint. However, such using thumbprint is well known in the art as evidenced by Borza [see figure 8b].

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to use thumbprint as taught by Borza in combination with the combination of Grippi and Young.

Regarding claims 21-51 are also rejected for the same reasons as set forth above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 5:30AM to 2:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on 571-272-7695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dmd
6/05



Duy M. Dang
Patent Examiner